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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY J. MANCUSO and KEVIN GERACE

Appeal 2008-1789
Application 09/954,766
Technology Center 3600

Decided: July 14, 2008

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and JEFFREY T. SMITH, Administrative *Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1-5 and 9-12, which are the only claims pending in this application.[1] We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to a free-standing coil reel hold-down device which comprises a base plate operatively

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[1] Appellants' amendment canceling claims 6-8 was filed concurrently with the Amended Appeal Brief dated Apr. 23, 2007, (hereafter "App. Br.") and has been entered by the Examiner (App. Br. 3; Ans. 2, ¶(4); Reply Br. 2).

arranged to be secured to a floor, a snubber arm pivotably mounted to the base plate and arranged for pivoting rotation around a pivot point, the snubber arm including a first section and a second section disposed at an obtuse angle with respect to one another, and an actuator for effecting a pivoting movement of the snubber arm relative to the base plate (App. Br. 3). Independent claim 1 is illustrative of the claimed subject matter and is reproduced below:

1. A free-standing coil reel hold-down device, comprising:
a base plate operatively arranged to be secured to a floor;
a snubber arm having integral first and second sections arranged at an obtuse angle to one another, said snubber arm pivotably mounted to said base plate at a first end of said first section of said snubber arm and arranged for pivoting rotation about a pivot point proximate said base plate; and,
an actuator mounted to said base plate, and arranged to effect a pivoting movement of said snubber arm relative to said base plate, wherein said actuator is connected to said first section of said snubber arm between said pivot point and said second section of said snubber arm.

The Examiner has relied on the following prior art reference as evidence of unpatentability:[2]

Welp	US 5,518,199	May 21, 1996

[2] We note that this application has been the subject of a previous appeal (Appeal No. 2004-1602), with a Decision mailed on Aug. 20, 2004, affirming the Examiner's rejection of claims 1-3, 6, and 10 under § 102(b) as anticipated by Rodriguez, U.S. Patent No. 5,330,119; claims 4-5 under § 103(a) over Rodriguez in view of Orii, U.S. Patent No. 4,589,605; and claims 7-9, 11, and 12 under § 103(a) over Rodriguez (Decision 3). We also note that claim 1 has been amended since this Decision, and Rodriguez has not been applied against any pending claims now on appeal.

GROUNDS OF REJECTION ON APPEAL

Claims 1-5 and 9-11 stand rejected under 35 U.S.C. § 102(b) as anticipated by Welp (Ans. 3).[3]

Claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Welp (Ans. 5).

OPINION

Claim 1 on appeal stands rejected under 35 U.S.C. § 102(b) as anticipated by Welp (Ans. 3). Under § 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. *See In re King,* 801 F.2d 1324, 1326 (Fed. Cir. 1986).

Claim 1 on appeal requires that the coil reel hold-down device be "free-standing" (*see* claim 1 as reproduced above). Appellants contend that there is a clear difference between the claimed structure, which is free-standing with respect to another unit, and the structure of Welp, which is characterized as integral to a larger/other machine (App. Br. 10). Appellants contend that the Examiner has admitted that the structure of Welp is not free-standing (*id.*). The Examiner contends that the apparatus disclosed by Welp is "free-standing" since "nothing needs to be activated or de-activated to make it stand" (Ans. 3).

Implicit in our review of the Examiner's anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. *See Gechter v. Davidson,* 116 F.3d 1454, 1457 (Fed. Cir. 1997). During examination proceedings, the language

[3] We note that this rejection under § 102(b) is the only rejection presented for review in this appeal involving claim 1.

of the claims is given the broadest reasonable meaning as the words are ordinarily used as understood by one of ordinary skill in the art, taking into account any enlightenment afforded by the written description in the original specification. *See In re Morris,* 127 F.3d 1048, 1054 (Fed. Cir. 1997). The primary authority for construing a contested limitation should be Appellants' specification. *See Phillips v. AWH Corp.,* 415 F.3d 1303, 1313 (Fed. Cir. 2005).

From our review of Appellants' Specification, we determine that "free-standing," although not specifically defined in the disclosure, clearly in context and the drawings means that the coil reel hold-down device is separate from the coil reel, standing alone, and capable of being used with any number of uncoil/feeder models (Spec., ¶¶ [0008], [0013], [0036], and Figs. 3-5 and 7-8). We note that the Examiner fails to provide any basis for the contention that "free-standing" means "nothing needs to be activated or de-activated to make it stand" (Ans. 3).

As correctly argued by Appellants (App. Br. 10), we determine that Welp discloses that at least the peripheral drive 17 or slide and traverse parts 11 and 9 of his paper reel hold-down device are attached or secured by an unnumbered rod to the framework of the overall machine (*see* Figs. 1 and 2). We also note that the Examiner has failed to explain why the device disclosed by Welp should be considered "free-standing." Therefore, in view of our claim construction as discussed above, we determine that Welp does not disclose or describe a "free-standing" coil reel hold-down device as required by claim 1 on appeal. Accordingly, we cannot sustain the rejection of claim 1, and claims 2-5 and 9-11 which contain the same "free-standing" limitation, under § 102(b) over Welp.

Claim 12 has been rejected under § 103(a) over Welp with the Examiner stating that the particular angular range of movement of the snubber arm, as required by claim 12, would have been an obvious "design consideration" to one of ordinary skill in the art (Ans. 5). However, the Examiner has not explained why it would have been obvious to have the secured device disclosed by Welp in a "free-standing" position. Therefore, we cannot sustain this rejection for the reasons discussed above.

For the foregoing reasons, we reverse each ground of rejection presented for review in this appeal. The decision of the Examiner is reversed.

REVERSED

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